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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,224	10/02/2003	Duane C. Markley	EA12-003	3288

21567 7590 04/06/2005

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EXAMINER

PARSLEY, DAVID J

ART UNIT PAPER NUMBER

3643

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,224

Applicant(s)

MARKLEY ET AL.

Examiner

David J Parsley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 34-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-2-03, 1-10-05</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Preliminary Amendment

1. Applicant's preliminary amendment dated 3-16-04 has been entered into the application file.

Election/Restrictions

2. Applicant's election of Group I claims 1-33 and 43 in the reply filed on 1-10-05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 34-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 1-10-05.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 6, 14-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Parent claim 3 includes the limitation of the second handle portion being removable from the first handle portion. Therefore it is unclear to how the first and second handle portions are integrally formed as seen in claim 6 if they are removable from one another.

Claim 14 recites the limitation "the insertion member" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the cylindrical bore" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim appears to have a Markush grouping which is improperly indicated. The term "comprise" in line 2 should be replaced with - -consisting of one of a- -.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 16-21, 24-28, 30-33 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,355,611 to Dahlberg et al. and U.S. Patent No. 6,115,955 to Sledge.

Referring to claims 1, 4 and 26, Dahlberg et al. and Sledge disclose a fishing pole comprising, a handle assembly – at 4,14, of Dahlberg et al. and – at 10,16,54-68 of Sledge, a rod – at 2 of Dahlberg et al. and – at 34 of Sledge, carried by the handle assembly – see for example figures 1-8 of Dahlberg et al. and figures 1-3 of Sledge, wherein the handle assembly includes one or more weights – at 16a-16d of Dahlberg et al. and – at 58,60 of Sledge, configured to be removably mounted to the handle assembly to shift a center of mass of the fishing pole – see for example figures 1-8 of Dahlberg et al. and figures 1-3 of Sledge. Dahlberg et al. and Sledge further disclose the second handle portion has a selected length for tailoring centroid of the fishing pole – see for example figures 1-8 of Dahlberg et al. and figures 1-3 of Sledge.

Referring to claim 2, Dahlberg et al. and Sledge further disclose the one or more weights are removably attached to the fishing pole to shift the center of mass of the fishing pole between different positions in order to customize counter balance of the fishing pole according to user preferences – see for example figures 1-8 of Dahlberg et al. and figures 1-3 of Sledge.

Referring to claims 3 and 19, Dahlberg et al. and Sledge further disclose a first handle portion – at 4 of Dahlberg et al. and – at 10,16, of Dahlberg et al. and a second handle portion – at 14 of Dahlberg et al. and – at 54-68 of Sledge, removably attached to the first handle portion – see for example figures 1-8 of Dahlberg et al. and figures 1-3 of Sledge.

Referring to claims 5, 21 and 28, Dahlberg et al. and Sledge further disclose the second handle portion is configured to pivot about a point where the second handle attaches to the first handle portion – see at 52 in figure 2 of Sledge and – at figure 4 and column lines 62-68 and column 5 lines 1-10 of Dahlberg et al.

Referring to claim 7, Dahlberg et al. and Sledge further disclose the second handle portion comprises a longitudinal member – at 20,22, of Dahlberg et al. and – at 64,68 of Sledge, having proximal and distal end portions, and wherein the proximal end portion is located adjacent the first handle portion and the distal end portion is located away from the first handle portion – see for example figure 4 of Dahlberg et al. and figure 2 of Sledge.

Referring to claim 8, Dahlberg et al. and Sledge further disclose the one or more weights are provided adjacent the distal end portion of the second handle portion – see for example figure 4 of Dahlberg et al. and figure 2 of Sledge.

Referring to claim 16, Dahlberg et al. and Sledge further disclose a cross-sectional contour of the one or more weight members follows substantially a cross sectional contour of the handle assembly configured to receive the weight members – see for example figure 4 of Dahlberg et al. and figure 2 of Sledge.

Referring to claim 17, Dahlberg et al. and Sledge further disclose the one or more weights are made of metal – see for example column 5 lines 60-68 of Dahlberg et al. and column 7 lines 22-34 of Sledge.

Referring to claim 18, Dahlberg et al. and Sledge further disclose a counter-balancing apparatus for a fishing pole handle comprising, one or more weight members – at 16a-16d of Dahlberg et al. and – at 58,60, of Sledge, to be received by a handle assembly – at 4,14 of

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Dahlberg et al. and – at 1,16,54-68 of Sledge, of the fishing pole, the handle assembly including at least one handle portion – at 14 of Dahlberg et al. and – at 52-68 of Sledge, wherein the at least one handle portion is configured to removably receive the one or more weight members to cause a transfer of a center of gravity of the fishing pole between different positions – see for example figures 1-4 of Dahlberg et al. and figures 1-2 of Sledge, wherein the one or more weight members and the at least one handle portion have substantially equal radii so that upon assembly the one or more weight members appear to be integrally formed with the at least one handle portion – see the inner radius of item 14 and the outer radius of the weights – at 16a-16d in figures 1-4 of Dahlberg et al. and the inner radius of items 52-68 and the outer radius of the weights – at 58,60 in figures 1-2 of Sledge.

Referring to claims 20 and 27, Dahlberg et al. and Sledge further disclose the first handle portion is configured to support a fishing rod – at 2 of Dahlberg et al. and – at 34 of Sledge, and the second handle portion is configured to support the one or more weight members – see for example figures 1-4 of Dahlberg et al. and figures 1-2 of Sledge.

Referring to claims 23, 25 and 30, Dahlberg et al. and Sledge further disclose the one or more weight members have substantially equal radii and a distinct mass – see figure 2 of Dahlberg et al. and figure 2 of Sledge.

Referring to claims 24 and 31, Dahlberg et al. and Sledge further disclose the one or more weights – at 16a-16d of Dahlberg et al. and – at 58,60 of Sledge, have a surface contour that is substantially similar to a surface contour of the at least one handle portion – see for example figures 1-4 of Dahlberg et al. and figures 1-2 of Sledge.

Referring to claim 32, Dahlberg et al. and Sledge further disclose the one or more balancing weight members and the handle have substantially equal radii – see for example figures 1-4 of Dahlberg et al. and figures 1-2 of Sledge.

Referring to claim 33, Dahlberg et al. and Sledge further disclose the one or more balancing weight members and the handle have substantially equal radii to render the balancing weight members to appear as being integrally formed upon assembly of the weight members to the handle – see for example figures 1-4 of Dahlberg et al. and figures 1-2 of Sledge.

Referring to claim 43, Dahlberg et al. and Sledge disclose a handle for a fishing pole comprising, a structural member – at 4,8,9,14 of Dahlberg et al. and – at 10-20 and 52-68 of Sledge, for supporting a fishing reel – at 10 of Dahlberg et al. and – at SR or CR in figure 1 of Sledge, and at least one mass – at 16a-16d of Dahlberg et al. and – at 58,60 of Sledge, carried by the structural member for custom tailoring balance of the handle – see for example figures 1-4 of Dahlberg et al. and figures 1-2 of Sledge.

Claims 9 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sledge.

Referring to claim 9, Sledge discloses the distal end portion comprises female engagement grooves – see the threads in item 54 in figure 2, configured to receive complementary male engagement grooves – at the threads on item 62, provided on an end member – at 62, configured to receive the one or more weights – see for example figure 2.

Referring to claim 11, Sledge discloses the one or more weights – at 58,60, comprise a substantially equal radius – see for example figure 2.

Referring to claim 12, Sledge further discloses the one or more weights – at 58,60, and the second handle portion have substantially equal radii – see for example figure 2, wherein upon

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assembly, the one or more weights and the second handle portion appear to be integrally formed – see for example figure 2.

Referring to claim 13, Sledge further discloses the end member – at 62, comprises a screw – see the threaded portion in figure 2, in threaded engagement with a recess – at 54,56, provided in the distal end of the second handle portion to attach the one or more weights carried by the end member to the handle assembly – see for example figure 2.

Referring to claim 14, Sledge further discloses the insertion member comprises a head – see the rear portion of item 62, a shank – at the threaded portion of 62, having first and second ends, wherein the first end is attached to the head, and the second end includes the complementary male engagement grooves configured to be received by the female engagement grooves in the distal end portion of the second handle portion – at 54-56 – see for example figure 2.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlberg et al. or Sledge as applied to claims 3, 19 or 27 above, and further in view of U.S. Patent No. 4,467,548 to Tabor. Dahlberg et al. and Sledge do not disclose the first and second

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handle portions are integrally formed and lie in a common plane. Tabor does disclose first – at 14,15,21 and second – at 12,13 portions integrally formed and lie in a common plane – see for example figure 1. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Dahlberg et al. or Sledge and add the integrally formed handle portions of Tabor, so as to allow for the device to be cheaper and quicker to manufacture.

Claims 9 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlberg et al. as applied to claim 5 above, and further in view of Sledge.

Referring to claim 9, Dahlberg et al. does not disclose the distal end portion comprises female engagement grooves configured to receive complementary male engagement grooves on an end member configured to receive the one or more weights. Sledge does disclose the distal end portion comprises female engagement grooves – see the threads in item 54 in figure 2, configured to receive complementary male engagement grooves – at the threads on item 62, provided on an end member – at 62, configured to receive the one or more weights – see for example figure 2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Dahlberg et al. and add the second handle portion of Sledge, so as to allow for the weights to be quickly removed or added to the handle by the user.

Referring to claim 11, Dahlberg et al. as modified by Sledge further discloses the one or more weights comprise a substantially equal radius – see for example at 16a-16d in figure 2 of Dahlberg and – at 58,60 in figure 2 of Sledge.

Referring to claim 12, Dahlberg et al. as modified by Sledge further discloses the one or more weights – at 16a-16d of Dahlberg et al. and – at 58,60, of Sledge, and the second handle portion have substantially equal radii – see for example figure 4 of Dahlberg et al. and figure 2 of

Sledge, wherein upon assembly, the one or more weights and the second handle portion appear to be integrally formed – see for example figure 4 of Dahlberg et al. and figure 2 of Sledge.

Referring to claim 13, Dahlberg et al. as modified by Sledge further discloses the end member – at 62, comprises a screw – see the threaded portion in figure 2 of Sledge, in threaded engagement with a recess – at 54,56, provided in the distal end of the second handle portion to attach the one or more weights carried by the end member to the handle assembly – see for example figure 2 of Sledge.

Referring to claim 14, Dahlberg et al. as modified by Sledge further discloses the insertion member comprises a head – see the rear portion of item 62, a shank – at the threaded portion of 62, having first and second ends, wherein the first end is attached to the head, and the second end includes the complementary male engagement grooves configured to be received by the female engagement grooves in the distal end portion of the second handle portion – at 54-56 – see for example figure 2 of Sledge.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlberg et al. or Sledge as applied to claim 9 above, and further in view of U.S. Patent No. 4,467,548 to Tabor. Dahlberg et al. and Sledge do not disclose the one or more weights comprise a cylindrical bore. Tabor does disclose the one or more weights – at 10, comprise a cylindrical bore – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Dahlberg et al. or Sledge and add the weights with bore of Tabor, so as to allow for objects to be stored in the handle.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sledge or Dahlberg et al. as modified by Sledge as applied to claim 14 above, and further in view of Tabor.

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Sledge and Dahlberg et al. as modified by Sledge does not disclose the shank is configured to receive the one or more weights via the cylindrical bore of the respective one or more weights. Tabor does disclose the shank – at 21, is configured to receive the one or more weights – at 10, via the cylindrical bore of the respective one or more weights – see for example figures 1-2. Therefore it would have been obvious to one of ordinary skill in the art to take the device of Sledge or Dahlberg et al. as modified by Sledge and add the shank and weights of Tabor, so as to allow for the weights to be securely held to the handle assembly.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to weighted fishing rods in general:

U.S. Pat. No. 2,000,263 to Teetor – shows fishing rod with rotatable handle

U.S. Pat. No. 2,018,923 to Potter – shows fishing rod with weighted handle

U.S. Pat. No. 2,293,559 to Patterson – shows fishing rod with rotatable handle

U.S. Pat. No. 2,578,663 to Beaupre – shows fishing rod with weighted handle

U.S. Pat. No. 2,667,713 to Stephens – shows fishing rod with weighted handle

U.S. Pat. No. 3,981,095 to Shephard – shows fishing rod with helical line guide

U.S. Pat. No. 5,535,539 to Vetre – shows fishing rod with weighted handle

U.S. Pat. No. 5,803,384 to Epperson – shows fishing rod with weighted handle

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U.S. Pat. No. 5,953,847 to Peterson – shows fishing rod with helical line guide

U.S. Pat. No. 6,314,617 to Hastings – shows fishing rod with weighted handle

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J Parsley whose telephone number is (703) 306-0552. The examiner can normally be reached on 9hr compressed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DP

David Parsley
Patent Examiner
Art Unit 3643


PETER M. POON
SUPERVISORY PATENT EXAMINER

3/30/05